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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,296	05/30/2001	Tatsushi Nashida	450100-03302	7330

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

HOSSAIN, FARZANA E

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,296

Applicant(s)

NASHIDA ET AL.

Examiner

Farzana E. Hossain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to communications filed 09/27/2006. Claims 1-6 are pending. Claims 1 and 4 are amended. Claim 2 is previously presented. Claims 3, 5, 6 are original. Claim 7 is cancelled.

Response to Arguments

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's failure to adequately traverse the Examiner's taking of Official Notice for Claim 3 in the last Office Action is taken as an admission of the facts noticed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (US 6,311,011) in view of Zigmond et al (US 6,698,020 and hereafter referred to as "Zigmond") and Ellis et al (US 2003/0149988 and hereafter referred to as "Ellis").

Regarding Claims 1 and 4, Kuroda disclose a recording system for recording and/or reserving a broadcast program (Figure 1) and a recording substitution system for substitutionally recording a broadcast program (Figure 1), comprising: means for accepting a request to record and/or reserve a broadcast program (Column 4, lines 18-50); storage means for recording a broadcasting program (Column 4, lines 18-50, Figure 2, 103, 105); connection means for connecting with an external device (Column 5, lines 60-65); means for receiving a broadcast program (Figure 1, Figure 2) determination means for determination whether it is possible to record a broadcast program requested to recorded and/or reserved (Column 5, lines 60-65); means for issuing a recording substitution request to an external device via the connection means in response to a negative result of the determination (Figure 22, Figure 7). Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding broadcast in the storage means (Column 5, lines 60-65, Figure 7). Kuroda discloses the recoding system or recording substitution system receives and records television programs in the storage means or the external device, which inherently comprises commercials. Kuroda is silent on user information management means for storing user information about each requesting origin, and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means and

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inserting the information in a recorded program and wherein the recording system is charged for program reservation substitution services at a metered rate according to recording time.

Zigmond discloses user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means to the external device and inserting the information in a recorded program or the household device or advertisement insertion device has a connection means to external devices including video tape or any other medium carrying recorded video programming which has the stored video program and advertisements appropriate for a user attribute is inserted into the recorded program (Figure 5, Figure 6). Ellis discloses means for accepting a request to record and/or reserve a broadcast program (Page 8, paragraphs 0098-0103); storage means for recording a broadcasting program (Figure 7, 31, 32); connection means for connecting with an external device or remote media server (Figure 7, 29) and wherein the recording system is charged for program reservation substitution services at a metered rate according to recording time (Page 12, paragraph 0136).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include that the user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means to the external device and inserting the information in a recorded program or the household device or advertisement insertion device has a

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connection means to external devices including video tape or any other medium carrying recorded video programming which has the stored video program and advertisements appropriate for a user attribute is inserted into the recorded program (Figure 5, Figure 6) as taught by Zigmond in order to provide advertisements that are more interesting to the viewer so that premium payment from the advertiser (Column 1, lines 23-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include recording system is charged for program reservation substitution services at a metered rate according to recording time (Page 12, paragraph 0136) as taught by Ellis in order to for the head end to make a profit on services provided to the user.

Regarding Claim 2, Kuroda, Zigmond and Ellis discloses all the limitations of Claim 1. Kuroda discloses the determination means generates a negative result when a remaining capacity of the storage means is not sufficient for recording a broadcast program requested to be recorded and/or reserved (Figure 7, Column 5, lines 60-65).

Regarding Claim 3, Kuroda, Zigmond and Ellis discloses all the limitations of Claim 1. Kuroda, Zigmond and Ellis are silent on the determination means generates a negative result when a failure in the system prevents a broadcast program from being recorded in the storage means. Official Notice is taken as it would have notoriously well known to include redundant storage devices in the situation wherein a given storage device is not working or failing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Kuroda, Zigmond, and Ellis to include the claimed limitation for the benefit of ensuring a

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program is recorded in situations of a recorder failing or not working. Applicant's failure to adequately traverse the Examiner's taking of Official Notice for Claim 3 in the last Office Action is taken as an admission of the facts noticed.

Regarding Claim 5, Kuroda, Zigmond and Ellis discloses all the limitations of Claim 4. Kuroda discloses when the recorder is connected with the Internet; the video recorder may store signals via World Wide Web in the temporary storage device (Column 12, lines 28-44). It is noted that the World Wide Web records data from a plurality of external devices (plurality of users) and the substitution means is located upstream from the user and records program per users requests.

Regarding Claim 6, Kuroda, Zigmond and Ellis discloses all the limitations of Claim 4. Kuroda discloses comprising user information management means for storing user information about each requesting origin, wherein the recording substitution means records a broadcast program in a format appropriate for a user attribute of the requesting origin including HDD format, DVD format or VCR format (Figure 1, 105, Figure 7, Figure 22).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farzana E. Hossain whose telephone number is 571-272-5943. The examiner can normally be reached on Monday to Friday 8:00 am to 4:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FEH

October 31, 2006


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600